REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-10 are pending in this application. Claims 1-3, 7, 8, and 10 have been withdrawn from further consideration. Pending claims 4-6 and 9 have been amended to correct the claim dependencies and typographical errors. Also, the definitions of substituents R^4, R^5, and A have been amended in claims 4 and 5. New claims 11 and 12 have been introduced. Support is found throughout the specification as originally filed, in Tables III and IV and in claim 4. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. It is submitted that the amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 102 ARE OVERCOME

Claims 4 and 5 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Rousseau (WO 2201/94315). Applicants respectfully traverse in view of the claims as amended. The cited reference does not anticipate the pending claims.

It is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.,* 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller,* 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue,* 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Examiner asserts that compound of structure (V) of Rousseau anticipates the compounds of general formula I of claims 4 and 5.

Although Applicants do not agree with the rejection, in the interest of expediting prosecution, claims 4 and 5 have been amended. Rousseau does not disclose the compounds of the pending claims 4 and 5.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 are respectfully requested.

II. THE 35 U.S.C. §103 REJECTIONS ARE OVERCOME

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rousseau (WO 2201/94315). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rousseau (WO 2201/94315) in view of Akers (Journal of Pharmaceutical Sciences (2002) 91:2283-2300).

The Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: "[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are…ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727. Furthermore, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

The Examiner asserts that it would be "obvious for a person skilled in the art to replace a hydrogen group of the compound described in the prior art with a methyl group and a C1-alkyl with a C2-alkyl, with the motivation of obtaining compounds with similar chemical, physical and biological properties, thus resulting in the practice of claim 6, with a reasonable expectation of success".

Contrary to the Examiner's assertion, there is no motivation of modifying compounds of formula (V) to obtain the compounds of the pending claims as amended. Rousseau does not teach or suggest the claimed compounds of formula (I). Hydroxymethylamino compounds of formula (V) of Rousseau do not exhibit the same chemical properties as compounds of the present invention. Hydroxymethylamino compounds, where A-linker is methylene are known to be less stable than compounds having A-linker as C_2-C_3 or higher alkyl and R^5 substituent other than hydrogen as disclosed in one of the embodiments of the present invention. Furthermore, Rousseau pertains to the process for the preparation of compounds of formula (I) where compound of formula (V) is an intermediate. The reference describes 5-aminomethyl compounds of formula (I) as pyrazole pesticide compounds, but does not relate to compounds of formula (V) as pesticides. As such, one skilled in the art would not be able to predict pesticidal activity of the claimed compounds as disclosed in Examples A-E (page 22 of the specification as published) based on the compound (V) of the cited reference. Therefore, claim 6 and by dependency claim 9 as amended are not obvious in view of the cited reference.

In view of the foregoing remarks, the cited reference does not render the pending claims *prima facie* obvious. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.